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Docket No. G-091US04DIV
Serial No. 09/992,600Remarks

Claims 55-93 are pending in the subject application. By this Amendment, Applicants have canceled claims 61-65, 72-76, 82, and 89-93 and amended claims 55, 66, and 77. Support for the amendments can be found throughout the subject specification and in the claims as originally filed. Claims 56-60 and 66-71 read on the elected invention and are under examination; claims 77-81 and 83-88 stand withdrawn from consideration as being drawn to non-elected inventions. Entry and consideration of the amendments presented herein is respectfully requested. Accordingly, claims 55-60, 66-71, 77-81, and 83-88 are currently before the Examiner and favorable consideration of the pending claims is respectfully requested.

As an initial matter, Applicants gratefully acknowledge the Examiner's indication that claims 56-60 and 67-71 are objected to but would be allowable if rewritten into independent form to include the limitations of any base and intervening claims. Applicants have amended the claims to recite the subject matter indicated as allowable and respectfully submit that the amendments presented herein place the subject application in condition for allowance.

Applicants gratefully acknowledge the Examiner's withdrawal of the objections to the specification and the rejections under 35 U.S.C. §§101, 102(b) and 112, first and second paragraphs. Applicants also acknowledge that the Patent Office may, where appropriate, require applicant, under 35 U.S.C. § 121, to elect claims to either the product or process and that claims directed to the non-elected invention are withdrawn from further consideration under 37 C.F.R. § 1.142. However, Patent Office policy related to the treatment of product and process claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b) indicates that if applicant elects claims directed to the product and the product is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product will be rejoined. With respect to this policy, Applicants respectfully submit that claims 77-81 and 83-88 relate to withdrawn process claims that include all the limitations of, or depend from, the product claims under examination in this matter. Should the product claims currently under examination in this matter be found allowable by the Patent Office, Applicants respectfully request that the Patent Office rejoin claims 77-81 and 83-88 and that these claims be allowed as well.

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In the previous Office Action, the Examiner indicated that the title of the invention is not descriptive and that a new title is required that is clearly indicative of the invention to which the claims are directed. By this Amendment, Applicants have now included a request to amend the title of the invention to "Serine Carboxypeptidase hx (SCPhx) and Compositions Thereof" which more clearly indicates the claims to which the invention is directed. Accordingly, reconsideration and withdrawal of this objection is respectfully requested.

Claims 55, 61-66, and 72-76 are rejected under 35 U.S.C. § 112, first paragraph, as nonenabled by the subject specification. Applicants respectfully assert that claims 55, 61-66, and 72-76 are enabled by the subject specification. By this Amendment, Applicants have amended claim 55 and canceled claims 61-66 and 72-76 such that the enablement rejection is now moot. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

Claims 31, 34, 35, 37, and 40 are rejected under 35 U.S.C. § 102(b) as anticipated by Fong *et al.* (WO 99/14234). Applicants note that claims 31, 34, 35, 37, and 40 were canceled in the previous Amendment and are not currently pending in the subject application. Applicants believe the Examiner intended to indicate that claims 64, 65, 75, and 76 were rejected. Applicants respectfully disagree with the Examiner's assertion that the Fong *et al.* reference teaches a polypeptide comprising an amino acid sequence of at least 90% identity with amino acids -26 to 267 of SEQ ID NO: 4 and Applicants submit that Fong *et al.* does not anticipate the claimed invention. Fong *et al.* discloses a 452 amino acid polypeptide further referred to as AAY05768. An alignment between SEQ ID NO: 4 and AAY05768 is attached hereto. The AAY05768 sequence comprises a segment of 262 amino acids that is 100% identical to amino acids -26 to 236 of SEQ ID NO: 4 of the subject application (an amino acid sequence 293 residues in length). Applicants respectfully submit that the polypeptide of Fong *et al.* is only 89.4% identical to the 293 amino acids of SEQ ID NO: 4 ($262/293=0.8942$). The AAY05768 sequence further comprises a segment of 236 amino acids that is 100% identical to amino acids 1 to 236 of SEQ ID NO: 4 of the subject application. Applicants submit that this 236 amino acid sequence is only 88.4% identical to the 267 amino acids of SEQ ID NO: 4 ($236/267=0.8839$). Accordingly, Applicants respectfully submit that Fong *et al.* does not disclose a polypeptide comprising an amino acid sequence at least 90% identical to a polypeptide comprising amino acids 1 to 267 of SEQ ID NO: 4 nor does it disclose a polypeptide comprising an

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amino acid sequence at least 90% identical to a polypeptide comprising amino acids -26 to 267 of SEQ ID NO: 4. However, in order to expedite prosecution of the subject invention to completion, Applicants have canceled claims 64, 65, 74, and 76, thereby rendering this rejection moot. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(b) is respectfully requested.

It should be understood that the amendments presented herein have been made solely to expedite prosecution of the subject application to completion and should not be construed as an indication of Applicants' agreement with or acquiescence in the Examiner's position. Applicants expressly reserve the right to pursue the invention(s) disclosed in the subject application, including any subject matter canceled or not pursued during prosecution of the subject application, in a related application.

In view of the foregoing remarks and amendments to the claims, Applicants believe that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 CFR §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

Applicants invite the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephonic interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



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